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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,905

09/29/2003

Frank D'Amelio

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GANZ LAW, P.C.

P O BOX 2200

HILLSBORO, OR 97123

EXAMINER

LAMPRECHT, JOEL

ART UNIT

PAPER NUMBER

3737

MAIL DATE

DELIVERY MODE

05/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/675,905	Applicant(s) D'AMELIO ET AL.	
	Examiner JOEL M. LAMPRECHT	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/28/07, 12/13/06, 09/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 1-41 are objected to because of the following informalities: Regarding the claims as a whole, they are replete with language which does not positively recite any additional elements of the system. Examples include the use of the words "associated, supports, configuring, and additional" functional language before recited features which do not set forth any additional structural elements in the device. For further clarification, claim two recites "wherein the operational electronics supports a configurable component and the alteration provides alteration of the configurable component" which does not provide a positive recitation of the element to allow for one of ordinary skill in the art to determine the structural composition of the invention as claimed. Finally, the use of "software" does not comply with the standard for denoting a physical program on a tangible media and is therefore unacceptable for prosecution. Appropriate correction of all omissions of positive recitation is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1, 14, 17, 28, and 34, it is indefinite as to whether the structural elements which are recited in the claims are actually required by the system or simply are "associated", "configured" or "supported"

by the system as there is a substantial lack of positive recitation within the claims.

Regarding claims 6, 8, 10-12, and 20-22 the recitation of overcoming the “omission of software” conflicts the earlier recited “programming or configuring software”, “configurable component”, or “programmable component” does not positively set forth any additional structural elements and seems to contradict the claims from which these claims from which they depend from. Additionally, it is unclear to one of ordinary skill in the art as to what extent denotes when the claimed features are so broadly recited. The term “in whole or in part” in claims 6, 8, 10-12, and 20-22 is a relative term which renders the claim indefinite. The term “in whole or in part” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Finally, the term “configuring alteration software” as seen in multiple claims is not positively recited, lacks antecedent basis, and based on the claims as written is confusing with the term “configuring software”, “program alteration software” and “altering software”, even in light of the specification’s recitation of these terms.

Regarding claims 5, and 23-24, the use of the term “quasi-permanent” or “temporary” renders the claim indefinite as it is unclear what is meant by the term “quasi-permanent” or “temporary”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15, 17-26, and 28-41 rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al (US 6,184,922 B1). Saito et al disclose a medical device with

operational electronics (Col 16 Line 38-Col 17 Line 35), an alteration mechanism (Col 20 Line 1-Col 21 Line 55), a configurable component supported by operational electronics which is alterable (Col 20 Line 15-Col 22 Line 60), and programmable infrastructure which is also alterable (Col 12 Line 32-Col 14 Line 45). Additionally, Saito et al disclose the use of media which is programmable to alter (Col 7 line 55- Col 8 line 51 and Col 9 Line 40-Col 9 Line 68), configure, or program portions of the device and interface functionality (Fig 15, and). Saito also discloses circuit boards (Col 24, Line 50-62, Col 24 Line 1-33, and Col 21 Line 15-Col 22 Line 63) an imaging system including a scope and imaging camera (Claim 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al (US 6,184,922 B1) in view of Yokota (US 6,945,930 B2). Saito et al disclose the invention as claimed except do not recite the use of networking components for supporting networking capabilities. Attention is then directed to the secondary reference by Yokota which discloses the use of an imaging system with networking components (Fourth embodiment, specifically Col 31 Line 5- Col 68, more specifically Col 32 Line 30-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the networking capabilities of Yokota with the imaging system of Saito et al for the purpose of allowing for multiple users to have access to imaging data (Col 32 Line 20-37).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOEL M. LAMPRECHT whose telephone number is (571)272-3250. The examiner can normally be reached on Monday-Friday 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (571)272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3737

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian L Casler/
Supervisory Patent Examiner, Art
Unit 3737

JML